

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

Status of Claims

Claims 1-24 are currently pending in the application of which claims 1, 9, 15, 22, 23, 24 are independent.

In the Office Action dated April 4, 2010, claims 1-3, 7, 9, 11, 14-18, and 20-24 were rejected and claims 4-6, 8, 10, 12-13, and 19 were objected to.

By virtue of the amendments above, claims 22 and 23 have been amended to overcome the rejection under 35 U.S.C. §101. Support for the amendments may be found in the specification, for example, on page 26, lines 11-13.

No new matter has been introduced by way of the amendments above. Entry thereof is therefore respectfully requested.

Summary of the Office Action

Claims 4-6, 8, 10, 12-13, and 19 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claims 22 and 23 were rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter.

Claims 1-3, 7, 9, 11, 14, 15-18 and 20-24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over HP invent literature titled Structured Scaleable Meta-formats (SSM) for Digital Item adaptation to Mukherjee and Said (hereinafter

“Mukherjee/Said”) in view of U.S. Patent No. 6,393,215 to Washisu and further in view of U.S. Patent No. 6,600,432 to Green.

The aforementioned rejections are respectfully traversed for at least the reasons set forth below.

Allowable Subject Matter

The indication that dependent claims 4-6, 8, 10, 12, 13 and 19 would be allowable if rewritten in independent form is noted with appreciation. However, at this time, independent claims 1, 9, 15, 22, 23 and 24 have not been amended to include the subject matter of dependent claims 4-6, 8, 10, 12, 13 and 19 because Applicants believe that independent claims 1, 9, 15, 22, 23 and 24, as they are, are allowable over the prior art of record (See arguments below).

Claim Rejection Under 35 U.S.C. §101

Claims 22 and 23 were rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. In response, claims 22 and 23 have been amended to recite a device. As a result, it is believed that claims 22 and 23 are statutory. Withdrawal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be

sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

- **Claims 1-3, 7, 9, 11, 14-18 and 20-24:**

Claims 1-3, 7, 9, 11, 14-18 and 20-24 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Mukherjee/Said article in view of Washisu and Green.

This rejection is respectfully traversed because the Mukherjee/Said article is not prior art of the present application for at least the following reasons.

As stated in the previous Response, the Declaration under 37 C.F.R. §1.132 submitted on July 6, 2009 declared that the relevant portion (including sections 5.1.3 and 5.1.4) of the article authored by Mukherjee et al. titled “Structured Scalable Meta-formats (SSM) version 1.0 for Content Agnostic Digital Item Adaptation” (hereinafter referred to as “the Mukherjee article”) was Applicants’ own work. Therefore, the relevant portion of the Mukherjee article, including sections 5.1.3 and 5.1.4, was not prior art of the present application, and could not be used to reject the present application. That relevant portion of the Mukherjee article, including sections 5.1.3 and 5.1.4, is the same as section 5.3 of the Mukherjee/Said article. Therefore, section 5.3 of the Mukherjee/Said article is also not prior art of the present application.

In the Office Action, the Examiner disagrees with the explanations above. More specifically, in the “Response to Arguments” section of the Office Action, the Examiner

contends that the Declaration under 37 C.F.R. §1.132 to disqualify the Mukherjee article as prior art is not sufficient to disqualify the Mukherjee/Said article as prior art (See *Office Action*, pages 10-11). However, that assertion is respectfully traversed because section 5.3 of the Mukherjee/Said article has the exact same words as sections 5.1.3 and 5.1.4 of the Mukherjee article. Accordingly, it is impossible that section 5.3 of the Mukherjee/Said article is the work of a different author. In addition, Debargha Mukherjee has signed the Declaration under 37 C.F.R. §1.132 submitted on July 6, 2009 and acknowledged that willful false statements and the like are punishable under the law. Therefore, the Declaration under 37 C.F.R. §1.132 for section 5.1.3 and 5.1.4 of the Mukherjee article should be applicable to the work disclosed in section 5.3 of the Mukherjee/Said article. As such, it is respectfully requested that the Examiner accept the Declaration under 37 C.F.R. 1.132 dated July 6, 2009 as proof that section 5.3 of the Mukherjee/Said article is Applicants' own work and not prior art of the present application.

In addition, the Mukherjee/Said article was cited as being published on November 18, 2002. However, that November 18, 2002 date is for internal accession only (See bottom of page 1 of the Mukherjee/Said article). Thus, the date of November 18, 2002 is not the date that the article was disclosed to the public. The Mukherjee/Said article was disclosed to the public in January 2003 when it was published for the Proceedings of the Society of Photo-Optical Instrumentation Engineers, vol. 5018. *Id.* The filing date of the present application is November 26, 2003. Therefore, the Mukherjee/Said article was disclosed to the public less than one year from the filing date of the present application.

In view of the foregoing discussions, it is respectfully submitted that the present application cannot be rejected based on the Mukherjee/Said article under 35 U.S.C. §102(a)

or 103(a). Accordingly, the rejection of claims 1-3, 7, 9, 11, 14-18 and 20-24 under 35 U.S.C. §103(a) as allegedly being unpatentable over the Mukherjee/Said article in view of Washisu and Green must be withdrawn.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to Deposit Account No. 08-2025.

Respectfully submitted,

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By / Ashok K. Mannava /
Ashok K. Mannava
Registration No. 45,301
(703) 652-3822

MANNAVA & KANG, P.C.
11240 Waples Mill Road
Suite 300
Fairfax, VA 22030
(703) 865-5150 (facsimile)